

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte RICHARD H. HALL  
and THEODORE W. SELBY

Appeal No. 2002-1582  
Application 09/172,577

ON BRIEF

**MAILED**

**FEB 26 2003**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before COHEN, MCQUADE, and NASE, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Richard H. Hall et al. originally took this appeal from the final rejection (Paper No. 23) of claims 16, 17, 19, 20, 39, 42, 43, 46, 47, 50 through 53, 61 and 68. Claims 64 through 67 stand allowed, and claims 62 and 63, the only other claims pending in the application, stand objected to as depending from a rejected base claim.

In their briefs (Paper Nos. 29 and 34), the appellants indicate that claim 68 is no longer being appealed. Thus, the

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appeal as to claim 68 is hereby dismissed, leaving for review the standing rejections of claims 16, 17, 19, 20, 39, 42, 43, 46, 47, 50 through 53 and 61.

Before these rejections can be evaluated, however, we find it necessary to remand the application to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for clarification of the status of the declarations filed subsequent to final rejection on June 24, 2002 (Paper No. 38) and August 30, 2002 (Paper No. 42), respectively. As the record does not indicate whether or not these declarations have been entered, the examiner is directed to issue a supplemental answer (see 37 CFR § 1.193(b)(1)) stating whether the declarations have been entered or refused entry, and, if entered, explaining the examiner's position on the merits of the declarations vis-a-vis the rejections on appeal. Pursuant to 37 CFR § 1.193(b)(1), the appellants may file a reply brief in response to the supplemental answer.<sup>1</sup> If upon reviewing the record the examiner withdraws the

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<sup>1</sup> The appellants are advised that should the examiner refuse to enter one or both of the declarations, review of the refusal would be by petition to the Director rather than appeal to this Board. See In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971).

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appealed rejections, the requirement to issue the supplemental answer would, of course, become null and void.


In the event the application is returned to this Board with a supplemental answer for a decision on the merits of the appealed rejections, the examiner is further directed to append to the supplemental answer a full English language translation of Japanese Patent Document 2-82304 which is applied to reject certain of the appealed claims. This requirement stems from the Memorandum to the Patent Examining Corps from the Deputy Commissioner for Patent Examination Policy dated April 29, 2002 on the subject of "Reliance upon abstracts and foreign language documents in support of a rejection."


Finally, the record contains two papers (Paper Nos. 33 and 46) relating to a request for withdrawal of an associate attorney which do not appear to have been acted on by the technology center. On remand, these papers should be treated in accordance with prescribed USPTO practice.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D) (8th ed., Aug. 2001). Accordingly, it requires immediate action.

Further, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening of prosecution).

IRWIN CHARLES COHEN  
Administrative Patent Judge

  
JOHN P. MCQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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CHRISTOPHER JOHN RUDY  
209 HURON AVENUE  
PORT HURON, MI 48060